



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/352,734	07/13/1999	JAMES OWEN	SLA0193	2607

7590 03/11/2003

MARGER JOHNSON & McCOLLOM, P.C.
1030 S.W. MORRISON STREET
PORTLAND, OR 97205

EXAMINER

DANG, DUY M

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/352,734

Applicant(s)

OWEN ET AL.

Examiner

Duy M Dang

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/11/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/11/03 has been entered.

2. Claims 1-9 and 11-15 are currently pending.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmid et al. (US Patent No. 5,659,164. Art of record IDS (paper #2) filed 10/18/1999).

Regarding claim 1, Schmid teaches a method for controlling scanning device using control sheets (i.e., the "MRI such as the bar-coded information" shown in figure and mentioned in col. 4

Art Unit: 2621

lines 22-28 functions as the so called "controlling scanning device using control sheets"), comprising the steps of:

starting an imaging job having a multiple sheets (i.e., the "start scanner" shown at 14 of figure 3A; "place stack in feeder" shown in figure 2A; and "preparing a stack of successive sheets...digitizing scanner" mentioned in col. 3 lines 34-41. Also refer to "beginning of the document scanning" mentioned in col. 3 lines 42-43);

locating (i.e., the "place documents with cover sheets on scanner feeder" shown at 6 of figure 3A. Also refer to "recognizing...reading the machine-readable code markings of the cover sheet" mentioned in col. 3 lines 41-44) a control image on the control sheet within said imaging job (i.e., the "MRI" and "MRI (machine readable information)" included in the "cover page 1" as shown in figure 1 and mentioned in col. 4 line 22-28 function as the so called "a control image") wherein the control image sheets could be located anywhere within the imaging job (note the location of the "MRI" on the cover sheet 1 according to figure 1 and the location of the "barcode" mentioned in col. 5 lines 60-63);

processing (i.e., the "analyze, recognize" shown at 20 of figure 3B. Also refer to "computer (CP)" shown in figure 2A and mentioned at col. 4 lines 32-37) control instructions (i.e., the

Art Unit: 2621

"machine code" shown at 20 of figure 3B) from said control image; and

creating output in accordance with said control instructions (i.e., the "recording cover sheet info routing ID, config. parameter, etc." shown at 24 of figure 3B).

Regarding claim 8, Schmid teaches a method for controlling scanning device using control sheets (i.e., the "MRI such as the bar-coded information" shown in figure and mentioned in col. 4 lines 22-28 functions as the so called "controlling scanning device using control sheets"), comprising the step of:

starting an imaging job having multiple sheets (i.e., the "start scanner" shown at 14 of figure 3A; "place stack in feeder" shown in figure 2A; and "preparing a stack of successive sheets...digitizing scanner" mentioned in col. 3 lines 34-41. Also refer to "beginning of the document scanning" mentioned in col. 3 lines 42-43);

locating (i.e., the "place documents with cover sheets on scanner feeder" shown at 6 of figure 3A. Also refer to "recognizing...reading the machine-readable code markings of the cover sheet" mentioned in col. 3 lines 41-44) a control image on the control sheet within said imaging job (i.e., the "MRI" and "MRI (machine readable information)" included in the "cover page 1" as shown in figure 1 and mentioned in col. 4 line 22-28

Art Unit: 2621

function as the so called "a control image") wherein the control image sheets could be located anywhere within the imaging job (note the location of the "MRI" on the cover sheet 1 according to figure 1 and the location of the "barcode" mentioned in col. 5 lines 60-63);

creating output for said imaging job (i.e., the "recording cover sheet info routing ID, config. parameter, etc." shown at 24 of figure 3B); and

processing (i.e., the "analyze, recognize" shown at 20 of figure 3B) control instructions (i.e., the "machine code" shown at 20 of figure 3B) from said control image and using said control instruction for managing said output (i.e., the "set scanner parameters command: resolution, dither, mode, etc." shown at 23 of figure 3B).

Regarding claims 2, and 9, Schmid further teaches an image acquisition task (i.e., the "scanner" shown in figure 2C and mentioned in col. 3 lines 39-41 functions as the so called "an image acquisition task").

Regarding claims 3, and 10-11, Schmid further an image production task (i.e., the scanning document and storing document as a digitized document mentioned in col. 5 lines 35-38 functions as the so called "an image production task").

Regarding claims 4, and 12, Schmid further teaches a machine-readable format (i.e., the stack of pages shown in figure 1 contained printed information according to col. 2 lines 23-27 satisfies the so called "a machine-readable format").

Regarding claims 5, and 13, Schmid further teaches wherein said control image is text (i.e., the "human readable information (HRI)" shown in figure 1, and "printed information" (i.e., handwritten) mentioned in col. 2 lines 23-28).

Regarding claims 6, and 14, Schmid further teaches wherein said control image is numbers (i.e., the "human readable information (HRI)" shown in figure 1, "MRI" shown in figure 4 (note the numbers printed below barcode), and "printed information" (i.e., handwritten) mentioned in col. 2 lines 23-28 satisfy the so called "numbers").

Regarding claims 7, and 15 Schmid further teaches wherein said method includes the steps of locating a second control image on the second control sheet (see figure 3A, item 12: append new documents cover sheets and place entire stack on the feeder. Note the "MRI" included in the this stack having new document cover sheet corresponds to the so called "second control image on the second control sheet") and processing that control image (i.e., the "analyze, recognize machine code" shown at 20 of figure 3B).

5. Applicant's arguments filed 2/11/03 have been fully considered but they are not persuasive.

In reply to applicant's remarks with regard to claims 1 and 8 as stated in page 4 that claimed features of "the control image could be any where in the imaging job" refers to "out of order control sheets". It is noted applicant has failed to recite such features (i.e., "out of order control sheets") in the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, claim 1, for example, recites "the control image could be any where in the imaging job". Since Schmid teaches imaging job which includes placing stack of sheets in the feeder and the cover sheet attached to the stack also includes control image i.e., MRI as pointed out in the claim rejection section above, thus the MRI located on the cover sheet in Schmid meets applicant's control image in the imaging job.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 7033051464. The examiner can normally be reached on Monday-Thursday from 6:30AM-5:00PM.

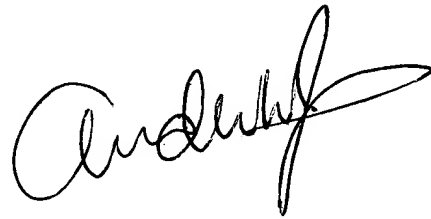
Art Unit: 2621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 7033054706. The fax phone numbers for the organization where this application or proceeding is assigned are 7038729314 all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 7033060377.



dmd
3/6/03



ANDREW W. JOHNS
PRIMARY EXAMINER